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EXAMINER  
CLAWSON JR, J

25M1/0209

ART UNIT PAPER NUMBER

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2511

DATE MAILED: 02/09/96

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☒ Responsive to communication filed on 9-18-95 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire THREE month(s), 16 days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- ☐ Notice of References Cited by Examiner, PTO-892.
- ☒ Notice of Draftsman's Patent Drawing Review, PTO-948.
- ☒ Notice of Art Cited by Applicant, PTO-1449.
- ☐ Notice of Informal Patent Application, PTO-152.
- ☐ Information on How to Effect Drawing Changes, PTO-1474.
- ☐

Part II SUMMARY OF ACTION

- ☒ Claims 21-28 are pending in the application.  
Of the above, claims \_\_\_\_\_ are withdrawn from consideration.
- ☒ Claims 1-20 have been cancelled.
- ☐ Claims \_\_\_\_\_ are allowed.
- ☒ Claims 21-28 are rejected.
- ☐ Claims \_\_\_\_\_ are objected to.
- ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.
- ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
- ☐ Formal drawings are required in response to this Office action.
- ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
- ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
- ☐ The proposed drawing correction, filed \_\_\_\_\_, has been ☐ approved; ☐ disapproved (see explanation).
- ☒ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☒ been filed in parent application, serial no. 061886876; filed on 7-18-86.
- ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
- ☐ Other

EXAMINER'S ACTION

Claims 21-28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 5,377,156. Although the conflicting claims are not identical, they are not patentably distinct from each other because when there is a "leakage current," as 5,377,156 claims at claim 1, and then when a "voltage" is applied across such a leaky load, this "voltage" is transformed into a source of "current." Since the disclosed "means" to generate such voltages/currents is exactly the same as that of the present application, there cannot be any difference in the circuit and the choice of the term "voltage" or "current" would be more a matter of semantics than an actual difference in circuit structure or function. The present claims are thus felt not patentably distinct over 5,377,156.

The non-statutory double patenting rejection, whether of the obvious-type or non-obvious-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78 (d).

Effective January 1, 1994, a registered attorney or agent of record may sign a Terminal Disclaimer. A Terminal Disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

It is noted that applicant, in his Preliminary Amendment A of September 13, 1994, Paper No. 5, makes reference to Figures 52A and 52B and "new drawings of Figs. 1, 52A, 52B, 55-57, 61, 64, 66, 69 and 70 are attached for the Examiner approval." However, there

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are apparently no such drawings separately submitted, and no Letter to the Draftsman submitted identifying any such proposed changes so that the examiner can duly consider same. Note that any changes to the Drawings should also have appropriate changes made in the specification in order to be self-consistent.

Any inquiry concerning this communication should be directed to Joseph Clawson at telephone number (703) 308-0956.



**JOSEPH E. CLAWSON, JR.**

**PRIMARY PATENT EXAMINER**

**ART UNIT 2511**

**Clawson/tj**

**February 8, 1996**